

Appl. No. 10/789,846
Amdt. Dated: Feb.8, 2006
Response to Office Action Dated Nov. 10, 2005

Remarks/Arguments:

This communication is in response to an Office Action dated November 10, 2005. Claims 1-8 and 10-16 are pending and stand rejected at present. Independent claim 1 and dependent claim 6 have been amended herein to place the application in condition for allowance. As such, applicants respectfully request reconsideration of this application.

Claims 1-7 and 10-16 are rejected under 35 U. S. C. 102(b) as being anticipated by disclosures in Walley 4,572,295, Peccoux et al. 4,918,121, Peck 5,211,827, JP-59-089383, or Raychem Corporation WO 94/03743.

Walley discloses methods of selectively reducing the water permeability of a subterranean formation (claim 1) by introducing the treatment agent into the formation through a shaft or well, and allowing the treatment agent to seep into the formation (col. 4, line 64 – col. 5, line 2). Applicants' believe Walley fails to teach a wellbore seal, but rather, teaches using a wellbore as a conduit to deliver treatment agent to a formation adjacent the wellbore. Hence, Walley does not anticipate Applicants' invention as claimed.

Peccoux teaches an organopolysiloxane composition curable into elastomeric state in a confined atmosphere, comprising an organopolysiloxane, crosslinking agent, inorganic fillers, and hydrogel, where the hydrogel comprises colloidal hydrogel and water (claim 1). The curable composition may serve to form a seal for use in the industrial, construction, and automobile industries (col. 9, line 67 through col. 10, line 42). Applicants believe Peccoux does not teach a wellbore seal as claimed by applicants, and as such, does not anticipate Applicants' invention as claimed.

Peck discloses an electrochemical cell comprising an anode, anolyte, cathode, catholyte, the catholyte having a different pH when compared to the anolyte, and a membrane which includes hydrogel dispersed in a matrix, but Peck fails to teach wellbore seals. Therefore, Peck does not anticipate Applicants' invention as claimed.

JP-59-089383 teaches a packing material used for construction applications, and does not teach wellbore seals. Raychem Corporation WO 94/03743 teaches sealing members which are pipe gaskets, or gaskets used as seals for CATV, telephone and

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power cable connectors, or closures for freebreathing aerial applications (page 8, lines 30 to 35). However, Raychem Corporation WO 94/03743 does not disclose wellbore seals.

Applicants believe therefore that neither Walley 4,572,295, Peccoux et al. 4,918,121, Peck 5,211,827, JP-59-089383, or Raychem Corporation WO 94/03743 anticipate applicant's invention.

Claims 1-8 and 10-16 are rejected under 35 U. S. C. 103(a) as being unpatentable over Walley 4,572,295, Peccoux et al. 4,918,121, Peck 5,211,827, JP-59-089383, or Raychem Corporation WO 94/03743. Claim 1 is amended herein, and insofar that the Examiner maintains the rejection, applicants traverse.

The prior art must provide a basis for modification. The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *Alza Corp. v. Mylan Laboratories Inc.*, 391 F.3d 1365, 1372-1373 (Fed. Cir. 2004). Also, even though the prior art could be modified, the art must still have suggested the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). Further, the motivation modify cannot derive from applicant's specification. It is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to "[use] that which the inventor taught against its teacher." *In re Lee*, 277 F.3d at 1343, citing *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). See *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988)("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Applicants' detailed reading of the references find no motivation suggested to modify any reference to achieve the invention as claimed.


Additionally, Applicant's point out that Walley teaches methods used only in a formation (col. 5, lines 6 to 32), while teaching away from use in wellbores (col. 5, lines 33 to 37). It is held that motivation may be lacking when the state of the art at the time of

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the invention in question was discovered pointed researchers in a different direction than the inventor proceeded. The Federal Circuit has repeatedly recognized that proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." In re Hedges, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986), for example. Hence, as Walley teaches away from use in a wellbore, motivation to modify the reference is even further lacking, and applicant's invention is non-obvious.

Amendments to the independent claims have been made to place the application in condition for allowance. Amendments made to the independent claims are applicable to the claims dependent thereon. Applicants submit that this paper is fully responsive to the comments in the Office Action and respectfully solicit for this application to be granted in light of these amendments and remarks. If the Examiner believes that the prosecution of the application would be facilitated by a telephone interview, Applicants invite the Examiner to contact the undersigned at 281-285-8606. The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0736).

Respectfully submitted,


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